

REMARKS/ARGUMENTS

The Examiner has now issued a new rejection under §112, a new rejection for double patenting, and new prior art rejections.

Applicant requests that the Examiner issue a final rejection so that Applicant may expeditiously take the issues up on appeal one more time.

Applicant has added new claims 23-50. Please find enclosed a check in the amount of \$672.00 as payment for the additional filing fee. Please charge any deficiency, or apply any surplus, to Deposit Account No. 50-0289.

Rejection Under §112

The Examiner has rejected claims 1-22 under §112 as being indefinite, because each of the independent claims uses the language "etc." and "substantially in a prescribed arrangement". Applicant believes that although usually the language "etc." is indefinite, in the context of the current invention and claims, the use of the term "etc." is clear and is not indefinite or ambiguous. Similarly, although in some contexts, the term "substantially" is considered to be indefinite, there are tens of thousands of patents containing the term "substantially" in claim language (simply perform a USPTO database search), and several court decisions have held that the use of such term in a patent claim being considered by the court does not render the claim indefinite. Applicant believes that the use of the term "substantially" in context of the instant invention and claims still renders the scope of the claims sufficiently clear so that the use of such term is not indefinite.

The Examiner also considers the use of the terms "the selected frames" or "the three selected frames" in the last paragraph of claims 1, 11-12, and 22 as lacking an antecedent basis. Applicant disagrees. For example, in claim 1, the reference in the last paragraph of claim 1 to "the selected frames" references the frames previously recited in the phrases "displaying in a selected frame" and "displaying in another selected frame". Accordingly, Applicant believes that there is sufficient antecedent basis for the phrases "the selected frames" and "the three selected frames" in the last paragraph of those claims.

The Double Patenting Rejection

The Examiner has issued a double patenting rejection under the judicially created doctrine of obviousness-type double patenting in view of the claims of the patent that issued on the parent patent application, U.S. Patent No. 6,319,123. When the final versions of any allowed claims in the instant application are determined, Applicant will evaluate whether the double patenting rejection is merited, and will respond accordingly.

The Prior Art Rejections Under §102

The Examiner previously rejected only claims 1 and 12 as being unpatentable under §102 as being anticipated by the Lermusiaux patent. Now the Examiner is rejecting claims 1, 4, 6, 10-13, 15, 17, and 22 under §102 as anticipated by Lermusiaux.

Lermusiaux teaches a video machine adapted for playing a wagering version of an American football game. As described in columns 5 and 6 of the Lermusiaux patent, a processor displays on a display screen 14 a picture of an American football field layout, randomly or quasi-randomly selects the field position for the play of the game, randomly selects a defensive player formation from a catalog of defensive formations, and displays the field position and the defensive formation. The player then (presumably non-randomly) selects an offensive player formation from a catalog of offensive formations, which selected offensive formation is also displayed on the display 14. In a somewhat ambiguously described operation, the processor "randomly selects the outcome based upon the defensive formation and the selected offensive formation" and awards the player certain points or money depending upon the outcome. The outcome may also be displayed "by animated, simulation of the play or by retrieving from a suitable data storage device such as a compact disk, actual video images of a live play run under similar circumstances."

In essence, the Lermusiaux patent teaches that after the winning outcome has been determined, the outcome may be displayed by selecting one of a series of motion pictures or movies of a football game play, each of which movies would inherently include time sequenced, non-identical images of the play as it evolves.

The images in the movies catalog in the Lermusiaux slot machine are displayed on a single display 14. There is no array of frames, and the images are not displayed in different frames in an array of frames.

The Examiner contends that each image in a movie inherently possesses a peripheral boundary, which may be deemed a border, which the Examiner further contends is a frame, such that the Examiner further contends that each such image inherently contained within its own "frame". Such conceptual terminology gymnastics do not arrive at the invention recited in the independent claims. If, as the Examiner contends each image inherently is "framed", then the language in claim 1 (and similar language in the other independent claims) to the effect "displaying in a selected frame a selected one of the first time images" would be non-sensical. Since the image already has a "frame" according to the Examiner's contrived analysis, would the claims then mean that the image is displayed in a different "frame"?

For at least the foregoing reason, independent claims 1, 11, 12, and 22 are not anticipated by the Lermusiaux patent. Since claims 4, 6, 10, 13, 15, and 17 are dependent from one of the foregoing four independent claims, such claims are also not anticipated by Lermusiaux.

The Prior Art Rejections Under §103

The Examiner previously did not make any rejection under §103 by combining the teachings of the Lermusiaux patent with U.S. Patent No. 6,375,568 to Roffman et al. Now, the Examiner has rejected claims 2-3, 5, 7-9, 14, 16, and 18-20 under §103 as being unpatentable in view of Lermusiaux and further view of Roffman.

In the interactive gaming system of Roffman, a player generally achieves a winning condition by lining up in a standard array of frames in a slot machine a series of identical symbols, such as symbols for a home run, symbols for a triple, symbols for a ball, etc. (column 9, lines 34-45 and column 10, lines 36-54). Although the Roffman patent discloses non-identical images that might occur at different times during an event, the Roffman patent does not disclose maintaining a library containing a plurality of series of non-identical images illustrating situations occurring at different sequential times during an event, nor does it disclose that the images in each series are identified as a first time image for the earliest image in the time sequence, a second time image

for the second earliest image in the time sequence, etc., as recited in each of the four independent claims. The Roffman patent also fails to disclose a winning condition as being a display in the selected frames of one of the series of time sequenced images depicting an event as recited in each of the four independent claims. Again, the Roffman patent describes a winning condition as being identical images.

The Examiner interestingly contends that "Roffman also teaches an arrangement of a plurality of frames for displaying video images to define an event". Here, the Examiner apparently adopts a definition of "frames" which is inconsistent with the definition adopted in connection with rejecting claims under §102 as being anticipated by Lermusiaux. The foregoing quoted statement indicates that the Examiner is now contending that the "frames" are different from the border or boundary that inherently defines the peripheral extent of an image.

The Examiner does nothing more than contend that Roffman teaches a conventional 3 x 3 array of slot machine frames and that somehow that array may be obviously implemented in connection with the teachings of the Lermusiaux patent.

The Examiner fails to address, let alone address in a convincing manner, how the teaching of Roffman that winning condition is a series of identical symbols should be overlooked or discarded in order to utilize the frame matrix or array taught by Roffman (and a host of other conventional, prior art slot machines) with the Lermusiaux game machine or how the procedure and process of the Lermusiaux game machine would be modified to display in a selected one of the frames of such a matrix a selected one of the first time images and to display in another frame of the matrix a selected one of the second time images and to establish as a winning condition the display in those frames of one of the series of time sequenced images depicting an event. The Examiner has opined:

One would be motivated to modify Lermusiaux to display the randomly chosen outcomes relating to sports games in a matrix format as taught by Roffman to allow for winning images events to be depicted in with real game images in a traditional slot game format rather than [sic] merely a text description of a game event as used in Roffman.

The foregoing statement is incomprehensible. What are "winning images events" and what are "winning images events to be depicted in with real game images"? Moreover, the magical use of the phrase "one would be motivated to modify" in a conclusory,

unsupported, bald allegation is simply insufficient to satisfy the Examiner's burden of demonstrating how prior art references contain a suggestion or motivation of how to combine the references in an obvious way to arrive at the claimed invention.

For the foregoing reasons, none of the four independent claims is obvious in view of the Lermusiaux and Roffman patents, and therefore, none of the claims dependent from any of those independent claims is obvious either. Since all of the claims 2-3, 5, 7-9, 14, 16, and 18-20 are dependent from one of the four independent claims, and since none of the independent claims is obvious in view of the Lermusiaux and Roffman patents, those claims are also not obvious and are patentable.

Comments on the Examiner's Response to Arguments

Applicant has reviewed the Examiner's Response to Arguments and believes that the Examiner has misconstrued both the prior art and the nature of the pending claims. The Examiner also indicates that:

The Examiner would also like Applicant to address the issue of how images commonly displayed on a video slot machine reels and their winning conditions are different from the instant invention.

Applicant believes that Applicant has already addressed this issue in the specification of the instant application, in connection with his previous arguments before the Examiner, and in his Appeal Brief. Further attempts would be fruitless, and Applicant believes that the matter should be resolved by the Board of Appeals.

The courts have frowned upon Examiners who have tried to fill in gaps between the prior art teachings and the claimed invention by resorting to concepts such as "desire of the developer" and "game designer's choice". Every invention, and every patentable invention, is achieved by an inventor's desire and choice, but that does not necessarily mean that such desire and choice involves a motivation or suggestion to combine the teachings of the prior art in an obvious way to arrive at a claimed invention.

Comments on the Patentability of the Newly Added Claims 23-50


The newly added claims each recite libraries, an array of display regions, and the selection and display of images from the library in the regions that are similar to those recited in the existing method claims. Applicant believes that his foregoing arguments with respect to the Examiner's rejection of the existing claims are equally applicable to the new claims.

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicant's attorney at the telephone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0289.

Respectfully submitted,

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